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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/609,431 | 06/27/2003 | Michelle D. Castro | 00-0122 | 7960 |

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| EXAMINER | |
|---|---|
| SAKRAN, VICTOR N | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3677 | |

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/609,431 | CASTRO, MICHELLE D. |
| | Examiner | Art Unit |
| | VICTOR N SAKRAN | 3677 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) *2* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

**Claim 2, should be canceled by an amendment to the claims and not in Applicant's remarks. Such is required.**

### *Claim Rejections - 35 USC § 103*

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

**The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

1. **Determining the scope and contents of the prior art.**
2. **Ascertaining the differences between the prior art and the claims at issue.**
3. **Resolving the level of ordinary skill in the pertinent art.**
4. **Considering objective evidence present in the application indicating obviousness or nonobviousness.**

**Claims 1 and 3-7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris U. S. Patent No. 5,590,545 in view of Wyeth U. S. Patent No. 1,401,227 (both are of record).**

**Norris discloses the general combination claimed of a strap retainer comprising a retaining member (11) having elongated main body portion (17) and opposite end portions for retaining said strap of a brassiere or the like, wherein each of said end portions including prongs (29,37,33,41) extending outwardly and spaced from said elongated main body portion (17) defining a slot there between for releasably receiving said strap without any holes, eyelets etc.; see Figures 1-3; column 2, lines 11-20; column 3, lines 9-15; 50-59, and column 6, lines 12-17, except that the reference to Norris is silent about using its retainer member for keeping the straps of a bra on a user's back in proximate relationship to one another, that the prongs are disposed in a plane with respect to its elongated main body portion and the opposing prongs defining an inverted C-shaped prongs with respect to the elongated main body portion. Wyeth teaches the use of a bar strap retainer comprising a retaining member (3) having an elongated main portion and opposite end portions which are adapted to keep the straps of a bra on a user's back in proximate relationship to one another. Wyeth also teaches the use of strap retainer (3) having an elongated main portion (4) and opposite end portions (5), wherein each of said end portions having a body portion comprising curved prongs extending outwardly therefrom and are disposed in plane with respect to its body portion defining C-shaped prongs (7), wherein said prongs of one end**

**portion facing the other prongs of the other end portion; see Figures 1-3; page 1, lines 17-18, 42-53. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the strap retainer member in Norris for keeping straps of a bra on a user's back in proximate relationship to one another, and further modifying the shape of its prongs to be in plane with respect to its elongated main body portion in the manner taught, disclosed and suggested by Wyeth, especially, since such modification involves only routine skill in the art.**

**Furthermore, Applicant is reminded that in considering the disclosure of a reference, it is proper to take into account not only specific teaching of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom; see In re Preda, 401 F2d 825, 826, 159 USPQ 342,344 (CCPA1968).**

**Moreover, the particular shape of the various elements is considered to be no more than a matter of design choice obvious to one having ordinary skill within the art at the time the invention was made, especially, since it has been held that the particular change in shape of an element in a prior art device is such a change considered no more than an obvious matter of design choice to one having ordinary skill within in the art. See In Re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1954).**

**Furthermore, the particular range of dimensions of the retaining member as recited in claim 7, are considered to be no more than an obvious matter of design**

**choice; especially, since it has been held that where the general conditions of a claim are disclosed in the prior art, therefore, discovering the optimum or workable ranges is also involves only routine skill in the art. See In Re Aller, 105 USPQ 233.**

***Response to Arguments***

**Applicant's arguments filed August 5, 2004, have been fully considered but they are not persuasive. Because the reference to Norris clearly teaches the use of a strap retainer comprising a retaining member having elongated main body portion and opposite end portions for retaining said strap of a brassiere or the like, wherein each of said end portions including prongs extending outwardly and spaced from said elongated main body portion defining a slot there between for releasably receiving said strap without any holes or eyelets and the reference to Wyeth teaches the use of a bar strap retainer for keeping the straps of a bra on a user's back in proximate relationship to one another, and the use of end portions having a body portion comprising curved prongs extending outwardly therefrom and are disposed in plane with respect to its body portion defining C-shaped prongs, and the prongs of one end portion facing the other prongs of the other end portion.**

**In response to applicant's argument that the cited references taken individually or collectively fail to teach or suggest Applicant's bra strap retainer. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).**

**In response to applicant's argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).**

**Furthermore, in an obviousness assessment, skill is presumed, on the part of the artisan, rather than the lack thereof. See In Re Sovish, 769 f. 2d 738, USPQ 771 (Fed. Cir. 1985).**

**THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR N SAKRAN whose telephone number is 703-308-2224. The examiner can normally be reached on 6:30 AM - 5:00 PM.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. swann can be reached on 703-308-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.**

**Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).**

**October 21, 2004**

**VICTOR N SAKRAN**
**Primary Examiner**
**Art Unit 3677**